

Application No. 09/164,348
Amendment "B" dated October 13, 2003
Reply to Office Action mailed May 16, 2003

REMARKS

In the Final Office Action dated May 16, 2003, the pending claims 1, 9-12, 20-22 and 33-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Thurlow (U.S. Patent No. 5,917,489) in view of Gainey (U.S. pub. 2002/0099681 A1). Claims 35 and 40 were also rejected under 35 U.S.C. § 112 for failing to provide sufficient antecedent basis for the term "standard priority". By this paper, claims 35 and 40 have been amended to fix the claim language so that there is proper antecedent basis for all of the recited terms. Claims 1 and 12, which have also been amended¹ by this paper, are the only independent claims that remain at issue in this case, of which claim 1 is a method claim and claim 12 is a corresponding computer program product claim.

The pending claims are directed to extending the protocol in messaging systems in order to allow customized operations to be performed on electronic messages and without deviating from the established messaging protocols.

As reflected in the claims list provided above, the claimed embodiments include the claim elements of storing a standard command that is based on a standard Internet protocol, as well as a user-created command that is based on an extension of the Internet protocol, each command being capable of manipulating the messages being used in the messaging systems. The claimed embodiments also include the assigning of a user-defined priority to the user-created command relative to the priority of the standard command, upon registering the user-created command, and the execution of at least one of the standard command and the user-created command in the appropriate order of relative priority, as assigned.

One benefit of enabling a user to set the priority of the registered user-defined commands, as disclosed in the specification, is that this type of prioritization can allow the user-defined commands to augment and bypass standard default commands, thereby enabling a user to add or remove features of an email system to create a full-featured, individually customized email system. (p. 9, ll. 2-8; p. 16, ll. 17-19).

¹ It will be appreciated that the changes made to the claims by this paper should not be construed as acquiescing in the purported prior art status of Thurlow or Gainey under 35 U.S.C. §§ 102(a)/(e). Accordingly, Applicants reserve the right at any time, as deemed necessary or appropriate by Applicants, to swear behind and/or challenge the purported prior art status of Thurlow or Gainey. Therefore, any arguments made herein regarding the cited art are made assuming, *arguendo*, that the cited art does indeed qualify as prior art.

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Although Thurlow and Gaincy are generally directed to methods and systems for creating/applying rules in email messaging systems, they fail to anticipate and obviate the specific embodiments that are recited in the pending claims, either singly or in combination, for at least the reasons that are disclosed herein. Initially, it is acknowledged in the Final Office Action that the Thurlow reference fails to disclose or suggest the claimed elements of assigning of a priority to the user-created command and the execution of the standard/user-created commands in any order of priority.

Gaincy also fails to teach these claimed elements of "assigning a user-defined priority to the user-created command relative to an assigned priority of the standard command; and executing at least one of the standard command and the user-created command in order of priority," particularly in combination with the other recited claim elements. In fact, Gaincy actually appears to teach away from assigning priorities in the manner recited in the claims.

For example, in contrast to the claimed embodiments, Gaincy teaches that the priority for determining the order in which rules are implemented is dependent upon the rule's position or order within a rule's list. The disclosure provided in Gaincy, however, does not appear to accommodate any customizable priority settings, particularly with reference or relation to standard rules, as is claimed in the present application.

At the very most, two or more user-created rules could be placed in a particular order during creation of the rule to affect their relative priority to each other. Gaincy fails to suggest or disclose any customizable priority setting that can be assigned to a user-defined command relative to a standard command. If anything, Gaincy actually appears to teach away from this by stating that "[s]ome rules...take priority over order." ¶ [0044]. As reflected in paragraphs [0045]-[0051], the priority of the rules that are created in the rule list can actually be indiscriminately trumped or overridden by default priority rules.

Even assuming, *arguendo*, that Gaincy did allow the assigning of user-defined priority for user-created commands relative to the priority of standard rules, which it doesn't, Gaincy clearly fails to teach that the user-defined priority is assigned only after the user-created command is registered in one or more databases that store the standard command, as is now recited in the amended independent claims.

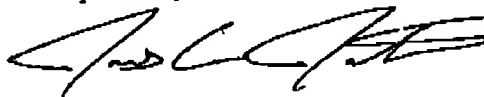
For at least these reasons, Applicant respectfully submits that the pending claims 1, 9-12, 20-22 and 33-42 are now in condition for prompt allowance. In the event that the Examiner

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finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 13 day of October 2003.

Respectfully submitted,



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